

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

DeGRADO *et al.*

Application No.: 10/801,951

(Appeal No. 2010-005832)

Filed: March 17, 2004

For: **Facially Amphiphilic Polymers and
Oligomers and Uses Thereof**

Confirmation No.: 2895

Art Unit: 1627

Examiner: CHONG, Yong Soo

Atty. Docket: 1694.0630003/JMC/M-R

**Petition Under 37 C.F.R. §§ 1.182 and 41.4
To Extend Time Period For Response to the Order Under 37 C.F.R. § 41.50(d)**

Chief Administrative Patent Judge
Appeal Related Matters
Board of Patent Appeals and Interferences
US Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

Pursuant to 37 C.F.R. §§ 1.182 and 41.4, Applicants hereby petition for a two-week extension of time to reply to the Order for Briefing ("the Order") mailed by the Board of Patent Appeals and Interferences ("the Board") on May 9, 2011. In the Order, the Board set a June 6, 2011 deadline for filing a Response.

This petition is being filed electronically in the matter of Ex Parte DeGrado *et al.*, Appeal No. 2010-005832, Application No. 10/801,951, Technology Center 1600. The petition fee under 37 C.F.R. § 1.17(f) in the amount of \$400.00 is submitted with this petition. Any part of the petition fee not paid herewith is hereby authorized to be charged to our Deposit Account No. 19-0036.

Background

Applicants filed a Notice of Appeal on May 4, 2009, appealing the final decision of the Examiner dated February 9, 2009, to the Board in the above-captioned application. The Examiner had finally rejected claims 16-48 and 67-73 under the judicially created doctrine of obviousness-type double patenting.

Applicants filed an appeal brief on September 23, 2009, requesting that the Examiner's rejection of pending claims 16-48 and 67-73 under the judicially created doctrine of obviousness-type double patenting be reversed and the claims be allowed to issue.

The Examiner mailed an Examiner's Answer on December 8, 2009, addressing Applicants' appeal brief regarding the rejection of pending claims 16-48 and 67-73 under the judicially created doctrine of obviousness-type double patenting. Applicants filed a Reply Brief on February 10, 2010, in response to the Examiner's Answer. A docketing notice was mailed by the United States Patent and Trademark Office on April 13, 2010.

On Monday, May 9, 2011, under 37 C.F.R. § 41.50(d), the Board mailed an order to Applicants to brief two newly raised questions by Monday, June 6, 2011. Neither question the Board ordered briefed deals with obviousness-type double patenting that was the subject of Applicant's appeal. Instead, the questions involve restriction practice and Markush claim drafting. Specifically, the issues the Board requested briefed are: "1. Whether Applicants may be required to restrict their claims to a single invention under the provisions of 35 U.S.C. § 121 and 2. Whether Claim 16 is a proper 'Markush Claim.'" (Order, page 2). Under Rule 41.50(d), the deadline for briefing the questions ordered by the Board is non-extendable. 37 C.F.R. 41.50(d).

On Monday, May 9, 2011, the Order was delivered by paper mail to Applicants' legal representative of record, Sterne Kessler Goldstein & Fox, P.L.L.C. ("Applicants' representative"). The Order was received and stamped into the mail room of Applicants' representative on Wednesday, May 11, 2011. Therefore, Applicants received the Board's Order only 26 days before the due date the Board established for filing a Response.

Argument


Applicants seek a modest extension of two additional weeks to brief the two important questions raised by the Board in the Order. The two questions are not directed to the obviousness-type double patenting rejection previously briefed by Applicants and the Examiner. Instead, the Board is requesting Applicants to brief the Board on new issues related to restriction practice and proper Markush claims.

Applicants wish to prepare and submit a brief that is fully and comprehensively responsive to the Order. However, because the two questions raised by the Board, unrelated and dissimilar to the issue previously briefed by Applicants and the Examiner, are complex, Applicants' representatives must conduct a thorough review of a large body of precedent as well as scholarly and proposed rulemaking material in a short amount of time, and apply it to the facts. Accordingly, Applicants request a brief two-week extension of time so that Applicants may thoroughly research these issues and properly provide the Board with a comprehensive brief that is able to assist the Board in reaching a proper decision on such complex issues.

Based on the foregoing, Applicants respectfully submit that the current circumstances represent adequate merit under 37 C.F.R. § 1.182 for a two-week extension of time. Applicants therefore respectfully request that this Petition be granted and that the time period for response be extended to Monday, June 20, 2011.

Respectfully submitted,

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